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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,669	02/06/2004	Steffen Dubnack	ZEI-3226/500343.20238	7534
20999 7590 03/16/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER				
EISEMAN, ADAM JARED				
ART UNIT		PAPER NUMBER		
3736				
MAIL DATE		DELIVERY MODE		
03/16/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,669

Applicant(s)

DUBNACK ET AL.

Examiner

ADAM J. EISEMAN

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to applicant's amendments and arguments/remarks filed on 11/19/2009.

Claim Rejections - 35 USC § 103

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers'426 (US 5,630,426) in view of Ciaff (US 2003/0100932), Eggers'304 (6,287,304), and Gonzalez (US 6,685,729).

Eggers'426 discloses a method for tissue-selective treatment in surgery comprising: placing a probe in an area of body tissue of a person being treated (column 5, lines 41-50); stimulating the area of the body tissue causing the probe to send different electrical and/or electromagnetic stimulus signals which can be preadjusted or modulated (column 5, lines 51-60); identifying the pathologically changed tissue parts in the area of body tissue by identifying those tissue parts for which the person being treated provides an unexpected stimulus response, wherein the response identified is distinct from the properties of the body tissue being stimulated (column 6, lines 46-52); treating the area of the body tissue, wherein the treatment comprises the probe, selecting and treating any pathologically changed tissue part (column 6, lines 53 – column 7, line 2); wherein, in the case of healthy tissue, the probe is repositioned and tissue selection is reactivated (column 10, line 64 to column 11, line 11).

However, Eggers'426 does not disclose that in identifying the pathologically changed tissue parts that the tissue is identified by where the response of the identified tissue is a change to the body's functioning distinct from the properties of the body

tissue being stimulated; or that the treatment of the tissue involves removing the identified changed tissue parts; or use of the device in the brain.

Ciaff teaches a method of testing tissue using modulated electrical pulses to stimulate tissue in order to identify pathologically changed tissue parts in the tissue by identifying the parts that provide no stimulus or unexpected stimulus wherein the identified response is a change to the body's functioning distinct from the properties of the body tissue being stimulated (paragraph [0012]).

Eggers'304 teaches use removal of pathologically changed tissue from the body as treatment (column 4, line 26 – column 6, line 24).

Gonzalez teaches testing brain tissue in an iterative test where tissue is stimulated, corrected of any defects, and re-stimulated/tested until functioning normally (column 11, lines 40-62; figure 1).

Regarding claims 1-3; Eggers'426 discloses testing tissue in order to identify pathological differences through identification of tissue properties such as impedance. It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute Eggers method of identifying pathologically changed tissue with Ciaff's method of identifying pathologically changed tissue by identifying responses where the response is a change to the body's functioning distinct from the properties of the body tissue being stimulated as simple substitution of one known element for another. Furthermore, it would have been obvious to substitute Eggers'426 method of treating the pathologically changed tissue (causing necrosis of cells) with Eggers'304 method of treating pathologically changed tissue (removing tissue from the body via cauterization)

as simple substitution of one known element for another. Finally, it would have been obvious to one of ordinary skill in the art at the time of the invention that the Egger'426/Ciaff/Eggers'304 combination could be used on brain tissue as taught by Gonzalez.

In regards to claim 2; Eggers'426 discloses the stimulus response is carried out by iterative transmission of stimulus signals (column 10, line 64 to column 11, line 11).

In regards to claim 3; Eggers'426 discloses a direct online tissue selection is carried out by alternating treatment and positioning with tissue selection and immediate evaluation of the stimulus responses (column 10, line 64 to column 11, line 11) and the user is warned during treatment of critical tissue regions (via display 45).

Response to Arguments

3. Applicant's arguments, see applicant's amendments and arguments/remarks, filed 11/19/2009, with respect to the rejection(s) of claim(s) 1-3 under Ciaff, Raymond and Gonzalez have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Eggers'426 in view of Ciaff, Egger'304 and Gonzalez as presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM J. EISEMAN whose telephone number is (571)270-3818. The examiner can normally be reached on Monday-Friday 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AE
3/12/2010
/A. J. E./
Examiner, Art Unit 3736

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736